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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,561	07/06/2001	Peter Bernard Kaars	US000171	5051

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Corporate Patent Counsel
U.S. Philips Corporation
580 White Plains Road
Tarrytown, NY 10591

EXAMINER

TRAN, NGHI V

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,561

Applicant(s)

KAARS, PETER BERNARD

Examiner

Nghi V. Tran

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 0205.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-5, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang, U.S. Patent No. 5,956,521.

3. With respect to claims 1 and 5, Wang teaches a method of providing a service to distribute electronic content to a plurality of addressees [26 i.e. client e-mail device] via a data network [see abstract and figs.1-4], the method comprising the acts of:

- identifying respective edge servers [24 i.e. local servers] in said network that are in close proximity with respective groups of addressees [26 i.e. client e-mail device] from among the plurality of addressees [fig.3];
- sending one copy of the electronic content to the identified respective edge servers [col.4, lns.19-39]; and

- enabling the identified respective edge servers to send individual copies of the electronic content to individual ones of the addressees in the identified edge server's respective group of addressees [col.4, Ins.39-46].

4. With respect to claims 3 and 7, Wang further teaches the electronic content comprises an e-mail [col.2, Ins.13-58].

5. With respect to claim 4, Wang further teaches sending a first portion of the electronic content to the respective identified edge servers [fig.3 and col.4, Ins.19-49].

6. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Anthias et al., U.S. Patent No. 5,856,978 (hereinafter Anthias).

7. With respect to claim 10, Anthias teaches a computer program product that includes a computer readable medium having instructions stored thereon generating individual copies of the electronic content for individual ones of the addressees upon receipt of the electronic content together with a list of addressees [see abstract and col.6, Ins.8-65].

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 6, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang as applied to claims 1 and 5 above, and further in view of Anthias et al., U.S. Patent No. 5,856,978 (hereinafter Anthias).

10. With respect to claims 2 and 6, Wang is silent on supplying a list of identifiers of the addressees of the identified respective edge server's respective group to the identified respective edge server.

In an electronic content distributing method, Anthias discloses supplying a list of identifiers of the addressees [i.e. a recipient list] of the identified respective edge server's respective group to the identified respective edge server [fig.3 and col.5, ln.35 - col.6, ln.58].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Wang in view of Anthias by supplying a list of identifiers of the addressees of the identified respective edge server's respective group to the identified respective edge server because this feature avoids an unnecessary duplication of messages that overloads the network and wastes computing power and storage at the mail servers [Anthias, col.2, lns.29-64]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Wang in view of Anthias in order to prevent duplication of mail messages at the source

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when the same mail message is being set to a plurality of destinations [Anthias, see abstract].

11. With respect to claims 12 and 13, Wang is silent on the supplied list of identifiers of the addressees of the identified respective edge server's respective group are addressable via the identified edge servers.

In an electronic content distributing method, Anthias discloses the supplied list of identifiers of the addressees of the identified respective edge server's respective group are addressable via the identified edge servers [fig.3 and col.5, ln.35 - col.6, ln.58].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Wang in view of Anthias by supplying a list of identifiers of the addressees of the identified respective edge server's respective group via the identified edge servers because this feature avoids an unnecessary duplication of messages that overloads the network and wastes computing power and storage at the mail servers [Anthias, col.2, lns.29-64]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Wang in view of Anthias in order to prevent duplication of mail messages at the source when the same mail message is being set to a plurality of destinations [Anthias, see abstract].

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang as applied to claim 4 above, and further in view of DiStefano, III, U.S. Patent No 6,631,400 (hereinafter DiStefano).

13. With respect to claim 11, Wang is silent on enabling the identified respective edge servers to add a second portion to the first portion; and enabling the identified respective edge servers to send the first and second portions to the individual addressees in the respective groups of addressees.

In an electronic content distributing method, DiStefano discloses enabling the identified edge server to add a second portion [i.e. target recipient profiles] of the electronic content to the first portion of the electronic content [fig.1]; and enabling the identified edge servers to send individual copies [i.e. bulk email only to the group of target recipients] of the electronic content to individual ones of the addressees in the respective groups [col.3, ln.52 - col.4, ln.34].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Wang in view of DiStefano by adding a second portion and sending individual copies in the respective groups because this feature enables to transmit email only to the group of target recipients [col.4, lns.23-29]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Wang in view of DiStefano in order to present marketing material to the groups of target recipients with the email server [col.4, lns.8-11].

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wang as applied to claim 5 above, and further in view of DiStefano, III, U.S. Patent No 6,631,400 (hereinafter DiStefano).

15. With respect to claim 8, Wang further teaches sending a first portion of the electronic content to the identified respective edge servers [fig.3 and col.4, lns.19-49].

However, Wang is silent on enabling the identified respective edge servers to add a second portion to the first portion; and enabling the identified respective edge servers to send the first and second portions to the individual addressees in the respective groups of addressees.

In an electronic content distributing method, DiStefano discloses enabling the identified edge server to add a second portion [i.e. target recipient profiles] of the electronic content to the first portion of the electronic content [fig.1]; and enabling the identified edge servers to send individual copies [i.e. bulk email only to the group of target recipients] of the electronic content to individual ones of the addressees in the respective groups [col.3, ln.52 - col.4, ln.34].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Wang in view of DiStefano by adding a second portion and sending individual copies in the respective groups because this feature enables to transmit email only to the group of target recipients [col.4, lns.23-29]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Wang in view of DiStefano in order to present marketing material to the groups of target recipients with the email server [col.4, lns.8-11].

Response to Arguments

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16. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. "Method and apparatus for matching registered profiles," by Sutcliffe et al., U.S. Patent No. 6,052,122.

b. "Method and system for delivery of targeted commercial messages," by COLEMAN, U.S. Patent Application Publication No. 2002/0026351.

c. "Method for restricting delivery of unsolicited e-mail," by Drummond et al., U.S. Patent No. 6,691,156.

d. "High bandwidth broadcast system having localized multicast access to broadcast content," by Donahue et al., U.S. Patent No. 6,101,180.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



ZARNI MAUNG

SUPERVISORY PATENT EXAMINER

Nghi V Tran
Patent Examiner
Art Unit 2151

NT